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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/719,375

03/08/2002

J. M. Dakka

98M034

7003

23455 7590 08/24/2009
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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

08/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/719,375	Applicant(s) DAKKA ET AL.	
	Examiner REBECCA L. ANDERSON	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-33 and 35-48 is/are pending in the application.
- 4a) Of the above claim(s) 10-12, 40 and 41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 26, 30-33, 35-39 and 42-48 is/are allowed.
- 6) ☒ Claim(s) 3, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 1-8, 13, 14, 16-25, 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/29/09, 7/7/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-14, 16-33 and 35-48 are currently pending in the instant application. Claims 1-8, 13, 14, 16-25 and 29 are objected. Claims 3, 27 and 28 are rejected. Claims 10-12, 40 and 41 are withdrawn from consideration as being drawn to non-elected subject matter. Claims 9, 26, 30-33, 35-39 and 42-48 appear allowable over the prior art of record.

Response to Amendment

Applicants' amendment filed 29 May 2009 has overcome the 35 USC 112 1st paragraph rejection by including the percent weight of the carbon dioxide. In regards to the 35 USC 112 2nd paragraph rejection, as applicant has deleted the references to the periodic table from claims 1, 2, 5-9, 13, 14, 16, 17, 19-26, 30-33, 35 and 37-39 the rejection has been withdrawn. In regards to claims 3, 27 and 28 as the claims still include the reference to the periodic table, the 35 USC 112 2nd paragraph rejection is maintained. As applicant has overcome the 35 USC 112 1st paragraph rejection, the process of preparing epoxyoctane is considered allowable. Therefore, according to MPEP 803.02, the search and examination of the claim has been expanded to include the entirety of the elected group I. Therefore, the claims have been searched and examined to the extent that they read on the elected group I. As the claims contain subject matter other than elected group I, the objection to the claims is maintained. In regards to Groups V and VI, applicants have requested the rejoinder of these groups with group I. Groups V and VI will not be rejoined with group I as they are drawn to processes which prepare different products than as in group I. Specifically, the claims

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40 and 41 prepare acids or alcohols and the instant elected invention is for the preparation of epoxides.

Claim Objections

Claims 1-8, 13, 14 and 16-25 are objected to as containing non-elected subject matter. Claims 1-8, 13, 14 and 16-25 presented drawn solely to the elected invention of group I would overcome this objection.

Claim 29 is objected to as being dependent upon a rejected base claim, but would appear allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims refer to a group IVB, metal. However, this statement renders the claim indefinite because the reference to the periodic table does not distinctly claim the elements that the applicant is trying claim. Applicant is reminded that a claim must stand alone to define the invention, and incorporation into the claim by reference to the specification or an external source is not permitted (Ex parte Fressola, 27 USPQ 2d 1608, BdPatApp & Inter. (1993)). Therefore, the claims are considered indefinite due to the incorporation of groups from the periodic table. This rejection can be overcome by specifically listing the elements, which applicant considers part of the invention, into the claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

22 August 2009

Rebecca Anderson
Primary Examiner
Art Unit 1626, Group 1620
Technology Center 1600